

## REMARKS

In the Office Action mailed on August 9, 2007 the Examiner noted that claims 1-15 were pending, and rejected claims 1-16. Claim 1, 9 and 13-16 has been amended, no claims have been canceled, no claim has been added and, thus, in view of the forgoing claims 1-16 remain pending for reconsideration which is requested. No new matter is believed to have been added. The Examiner's rejections are respectfully traversed below.

### Rejection under 35 U.S.C. § 101

The Office Action, on page 9, rejected claim 1 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claim provide no useful, concrete and tangible result. However, claim 1 has been amended to recite "notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101. Support can be found at page 12, lines 5-32 of the application.

The Office Action, on page 10, rejected claims 2-8 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 2 is so broad that it encompasses any type of commercial transaction thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument. It is submitted that the recitation of "making a **commercial transaction in a virtual world** on a network" in claim 2 has a practical application. Specifically, because the commercial transaction is "in a virtual world" setting taken place over a "network", real personal information of a user is protected. Therefore, one of ordinary skill in the art would clearly understand that claim 2 has a practical application. Thus, claim 2 and claims 3-8, which depend from claim 2, satisfy the requirements of 35 U.S.C. § 101.

The Office Action, on page 10, rejected claims 9-11 under 35 U.S.C. § 101 because the claims allegedly lacked patentable utility. Particularly, the Office Action asserted that the claims provide no useful, concrete and tangible result. However, claim 9 has been amended to recite a "notifying means for notifying the real personal information to an entity" to overcome the rejection under 35 U.S.C. § 101.

The Office Action, on page 10, rejected claims 12-15 under 35 U.S.C. § 101 because the claims were allegedly directed to non-statutory subject matter. However, claims 12-15 have been amended to recite "a system for managing a virtual city space within a virtual world" to overcome the rejection under 35 U.S.C. § 101.

The Office Action, on page 11, rejected claim 16 under 35 U.S.C. § 101 because the claim lacks patentable utility. Specifically, the Office Action asserted that claim 16 provides no

useful, concrete, and tangible result. However, claim 16 has been amended to recite "notifying the real personal information to an entity" to overcome the rejection.

Further, the Office Action rejected claim 16 under 35 U.S.C. § 101 because of preemption. Particularly, the Office Action asserted that claim 16 is so broad that it would apply to everyone on the Internet thereby having no "practical application". However, the assertion by the Office Action is traversed with an argument. It is submitted that at least one practical application of claim 16 is "managing registered information of the virtual user" and "managing registered information of the ... real user" to convert "virtual information into real information of a person". Moreover, the claim language is not so broad that it would apply to everyone, rather the language in claim 16 applies to "virtual users ... [and] virtual entities within the virtual world". Therefore, the language recited in claim 16 is not so broad as to have no practical application, as asserted by the Office Action.

Thus, in view of the foregoing, it is submitted that claims 1-16 satisfy the requirements of 35 U.S.C § 101. Accordingly, withdrawal of the rejections is respectfully requested.

#### **Rejection under 35 U.S.C. § 112**

The Office Action, on page 11, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for failing to comply with the written description requirement. Claim 1 has been amended to overcome the rejection. Support for the amendment can be found at Fig. 1 of the application.

The Office Action, on page 12, rejected claim 1 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 1 omits essential steps such as "creating virtual information from [the] registered information". According to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention". In this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claim. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "creating virtual information from [the] registered information" is an essential step. Claim 1 is directed to "communicat[e] to a manager ... virtual personal information ... and convert the virtual personal information into the real personal information based on registered information". Therefore, it is submitted that claim 1 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 12, rejected claims 1-16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. Particularly, the Office Action asserted that "virtual personal information" and "real personal information", as recited in claims 1, 2, 9, 12 and 16, could include anything. The assertion by the Office Action is traversed with an argument. Specifically, "virtual personal information" as recited in claim 1 is a "representation ... similar to that of real personal information". Stated another way, virtual personal information is information that represents the real information of the person (see Specification, page 8, line 13 to page 10, line 20). Therefore, one of ordinary skill in the art would clearly understand the meaning of "virtual personal information" and "real personal information" in light of the specification and would also clearly understand by simply reading the claim language recited in claims 1, 2, 9, 12 and 16. Thus, it is submitted that claims 1-16 satisfy the requirements of the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 12, rejected claims 2-8 under the second paragraph of 35 U.S.C. § 112 for omitting essential steps. Specifically, the Office Action, on page 12, asserted that claim 2 omits essential steps such as "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve real monetary transactions". However, as previously mentioned, according to MPEP § 2172.01 "a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the specification may be rejected under 35 U.S.C. 112, second paragraph, for failure to point out and distinctly claim the invention". In this case, the Applicants have not defined any essential feature in the Specification that has been left out from the language recited in the claims. Further, the Examiner is respectfully requested to particularly point out where in the specification the Applicant has asserted that "a step where the virtual information is created from real world information, a step where the commercial transaction in the virtual world is converted or realized in the real world since commercial transactions involve real monetary transactions" are essential steps. Claim 2 is directed to a commercial transaction method that allows a user to "mak[e] a commercial transaction in a virtual world on a network, based on virtual personal information of the virtual world received via the network". Accordingly, it is submitted that claim 2 satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

The Office Action, on page 13, rejected claim 16 under the second paragraph of 35 U.S.C. § 112 for indefiniteness. The Office Action asserted that there is no indication of how virtual information is communicated. However, claim 16, as amended, recites "communicating, via a network, virtual information of a virtual user to at least one of a plurality of virtual entities

within a virtual world". Therefore, claim 16, as amended, clearly points out how virtual information of a virtual user is communicated.

Further, the Office Action asserted that the recitation "managing registered information" in claim 16 is unclear. However, the Examiner's attention directed to the recitation "**managing registered information** of the virtual user and real user **to convert** virtual information into real information of a person" in claim 16. It is submitted that one of ordinary skill in the art would clearly understand when reading the above-quoted claim language that "registered information of the virtual user" and "registered information of ... [the] real user" is managed "**to convert** virtual information [of the virtual user] into real information of a [real] person". Therefore, claim 16 fully satisfies the requirements under the second paragraph of 35 U.S.C. § 112.

Accordingly, withdrawal of the rejections is respectfully requested.

#### **Rejection under 35 U.S.C. § 102**

The Office Action, on page 13, rejected claim 1-16 under 35 U.S.C. § 102(e) as being anticipated by Shiloh (U.S. Publication No. 2001/0037316).

In the Response to Argument, on page 2 of the Office Action, the Examiner asserted that similar support can be found in Shiloh's provisional application. However, the Examiner has not indicated where such support can be found. The Examiner's attention is respectfully directed to the priority document filed with the Response on November 9, 2007, claiming priority over Shiloh. As such, Shiloh has been disqualified as prior art under 35 U.S.C. § 102 (e) because of the above-mentioned filed priority document. Therefore, it is submitted that the Examiner must issue a new non-final Office Action since the Applicant has claimed priority over Shiloh. Further, the Examiner is respectfully requested to indicate with specificity where in the provisional application of Shiloh the features of claims 1-16 are disclosed.

The Office Action, at item 15a on page 14, asserted that the bottom of paragraph 18 Shiloh discloses "a communication network that includes the Internet, intranets, and local networks". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15b on page 14, asserted that the middle of paragraph 20 of Shiloh discloses "a real entity represented by a virtual entity "... with an imaginary name, an

imaginary address, a virtual social security number, and any other data that may be required for the Internet activity of the virtual entity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15c on page 14, asserted that paragraphs 21 and 25 and 27 of Shiloh disclose "a computer system that manages both the real and virtual personal ... and provides a link between the virtual user and the real user". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15d on page 14, asserted that paragraph 22 of Shiloh discloses the "ability to conduct commercial transactions on the Internet using a virtual personality". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15e on page 14, asserted that the middle of paragraph 31 of Shiloh discloses "shipping items to a real address based on a virtual transaction by a virtual entity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15f on page 14, asserted that the middle of paragraph 26 of Shiloh discloses "the ability of a virtual person to authenticate (confirm) a transaction on the Internet using a fictional user name and information". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a

separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15g on page 14, asserted that paragraph 85 of Shiloh discloses "the user logs into a site by ... presenting the virtual user access ID and virtual user access password ... to gain access to their virtual identity". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15h on page 14, asserted that paragraph 20 of Shiloh discloses "a virtual entity may obtain a virtual debit and credit card number". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15i on page 14, asserted that the middle of paragraph 31 of Shiloh discloses that "virtual users are able to make purchases of goods, presumably from virtual stores". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15j on page 15, asserted that the middle of paragraph 35 and paragraph 20 of Shiloh discloses that "users can have personalized virtual home pages that serve as homes for entities and a ... virtual entity may enter a chat room and interact with other real and/or virtual entities". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15k on page 15, asserted that paragraph 21 of Shiloh discloses that "the system ... may be an organization operating a server site or series of server sites providing access to the Internet and/or other services ...". Further, the Office Action

asserted that paragraph 23 of Shiloh discloses that "while virtual stations and virtual city space are not discussed, Shiloh has the capability of offering it in that they provide virtual address information and provide management of the system and that entities can change personalities, which would include their virtual address". However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15l on page 15, asserted that paragraph 21 of Shiloh discloses:

The system of the present invention is generally referred to herein as an Anonymous Virtual Personality Provider (AVPP). In an exemplary embodiment of the invention, an AVPP may include an organization and/or combination of computer hardware and/or software which provides services according to the system and method of the invention, such as an ISP, an Internet portal, financial services, shipping infrastructure, or any other system or organization that may be required in order to conduct business and/or to provide services on the Internet. For example, the AVPP may be an organization operating a server site or series of server sites providing access to the Internet and/or other services that may be required in order to implement and manage the virtual entities.

However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully requested to specifically point out where the alleged feature is disclosed in the provisional application.

The Office Action, at item 15m on pages 15 and 16, asserted that paragraph 33 of Shiloh discloses:

[P]ayments by a virtual personality over the Internet may be in the form of a virtual credit/debit cards registered to the virtual personality. This may be implemented using a real credit card number that may be issued to the AVPP by an existing credit card company. The AVPP may be directly responsible for the payment of its virtual users' credit card bills. For billing and credit card authentication purposes, each virtual credit card of an AVPP user may be registered with the address of the AVPP and the fictional identification information assigned to each user. Therefore AVPP manages ... converting virtual information into real world information.

However, merely citing a publication that has been disqualified does not qualify as prior art under 35 U.S.C. § 102(e) unless the provisional application supports such disclosure. Since the provisional application of Shiloh is a separate reference in itself, the Examiner is respectfully

requested to specifically point out where the alleged feature is disclosed in the provisional application.

Therefore, in view of the foregoing, the Examiner is respectfully requested to issue a new non-final Office Action because the Office Action, mailed January 25, 2008, improperly rejects claims 1-16 as failing to show where the features are allegedly disclosed in the provisional application of Shiloh.

Further, it is submitted that the provisional application of Shiloh fails to teach or suggest the features of claims 1-16 for the following reasons.

The provisional application of Shiloh is directed to a method and system that secures user identities and creates virtual users to enhance the privacy on a global computer network (see provisional application of Shiloh, page 1). Particularly, the provisional application of Shiloh describes a Virtunality System, which is a virtual personality provider, that is used to promote all Internet business and allow a user to use a virtual account to research and shop the Internet without disclosing the real identity of the user (see provisional application of Shiloh, page 1, paragraph 1 to paragraph 3). Stated another way, a user can conduct transaction with other Web sites using a virtual identity provided by Virtunality.

However, claim 1 is directed to a communication method that "communicat[es] to a manager, via a network, virtual personal information ... [that] includes a virtual address in a virtual city within a virtual world" so the manager can "convert the virtual personal information into the real personal information based on registered information". The provisional application is silent as to the above-quoted features in claim 1. Specifically, paragraphs 1-3 and Fig. 1 of the provisional application of Shiloh are silent as to how "the virtual personal information" is "[converted] into the real personal information" and is silent as to who does the "converting".

In claim 1, it is clear from the recitation that "converting ... [is] based on registered information" and that the manager does the converting. However, the provisional application of Shiloh is merely concerned with a proposed model for Virtunality having real world services with anonymous users and does not teach how information will be converted and by whom it will be converted. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted features of claim 1. Thus, it is submitted that claim 1 is patentable over the provisional application of Shiloh.

Further, claim 2 recites "making a commercial transaction **in a virtual world** on a network, based on virtual personal information of the virtual world received via the network".

However, Fig. 1 of the provisional application of Shiloh merely describes a user having Internet anonymity and describes a communication link between the user and the real world services, which are labeled under "Virtunality – Reality". One of ordinary skill in the art would clearly understand by viewing Fig. 1 in the provisional application of Shiloh that a user is using a virtual identity to communicate *in a real world environment* rather than a "transaction *in a virtual world*". Further, Fig. 1 clearly describes "real world services", "banking services", "privacy protection/promotion organization" but does not describe in any way that a "commercial transaction [is being made] in a virtual world" as in claim 2. Therefore, in view of the foregoing, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 2. Thus, it is submitted that claim 2 is patentable over the provisional application of Shiloh. Further, dependent claims 3-8 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 2, from which they depend.

With respect to claim 9, the last three lines on page 3 of the provisional application of Shiloh describes that linking between real identities and their corresponding virtual identities, for both debit and credit purposes, will be performed only within the internal accounting system of Virtunality, thereby fully protecting this crucial linking from being communicated to the Internet.

However, claim 9 recites "converting means for converting the virtual personal information received from the virtual city within the virtual world via a network into corresponding real personal information of the real world, based on the registered information". As previously mentioned, Shiloh fails to disclose as to how and what "convert[s] the virtual personal information received from the virtual city within the virtual world ... into corresponding real personal information of the real world". Rather, the last three lines on page 3 of the provisional application is merely concerned with who protects the information and does not teach how the information is converted and by what means the information is converted.

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-quoted feature recited in claim 9. Thus, it is submitted that claim 9 is patentable over the provisional application of Shiloh. Further, the dependent claims 10 and 11 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 9, from which they depend.

With respect to claim 12, the last paragraph on page 12 of the provisional application of Shiloh describes that Virtunality users will be provided with a virtual spending account to make Internet shopping attractive to privacy-oriented users. Further, paragraph 1 on page 5 of the provisional application of Shiloh describes that Virtunality will allow users to make transactions

with websites such as Priceline.com while protecting the real identity of the user.

However, in claim 12 "a commercial transaction [is] made between a first virtual individual and an arbitrary one of the virtual shops". The above-quoted feature is not taught or suggested in the provisional application of Shiloh because the provisional application of Shiloh is merely concerned with allowing a real user to use a virtual identity to make transactions in the real world. Specifically, the provisional application of Shiloh describes a real user can use a virtual identity to make transaction on Priceline.com (e.g. real store), for example and is not concerned with a real user using a virtual identity to make a "commercial transaction ... [with] an arbitrary one of the virtual shops" as required in claim 12.

Further, the third and fourth paragraphs on page 5 of the provisional application of Shiloh describes a Virtunality Product Line that is directed to allow a user to purchase virtual personalities to allow a user to lead a full virtual life. Specifically, the personalities in the provisional application of Shiloh are not purchased from a virtual shop but rather purchased from Virtunality (e.g. a real entity). Therefore, neither paragraph teaches or suggests "[making] a commercial transaction ... between a first virtual individual and ... the virtual shops" because the cited paragraph are merely concerned with Virtunality selling personalities to a user, rather than describing a commercial transaction with "an arbitrary one of the virtual shops". Further, the entire reference is silent as to making any type of transaction with any *virtual shop*.

Therefore, it is submitted that the provisional application of Shiloh fails to disclose or suggest at least the above-mentioned features recited in claim 12. Thus, it is submitted that claim 12 is patentable over the provisional application of Shiloh. Further, dependent claims 12-15 are also patentable over the provisional application of Shiloh for at least the same reasons as base claim 12, from which they depend.

In the Response to Arguments, on page 7 of the Office Action, the Examiner asserted that the Applicants specification indicates that a virtual shop in a virtual world can be indicated by a URL. Such an assertion by the Examiner is incorrect. The Examiner is respectfully requested to read page 9, line 36 to page 10, line 20 of the Specification in its entirety. The URL described in the Specification is an example of a way to describe a "virtual address", i.e. the location of the virtual shop within the virtual world". Such a "virtual address" recited in the independent claims 1, 2, 9 and 12 is not taught or suggested by the provisional application of Shiloh, but rather the provisional application of Shiloh is merely concerned making a transaction in the real world using a virtual identity. Therefore, based on this additional reason, the provisional application of Shiloh does not teach or suggest at least the above-mentioned feature recited in claims 1, 2, 9 and 12.

With respect to claim 16, the last paragraph on page 6 of the provisional application of

Shiloh describes that depending on the magnitude of business generated by Virtunality, and its growth Virtunality *may be able* to provide its users with any other existing Internet services. However, the cited paragraph does not teach or suggest how and by what means Virtunality will provide its user with *any* other existing Internet services. Such a blanket statement that that Virtunality may be able to provide does not teach or suggest how and by what means Virtunality will provide other existing Internet services. To that extent, the last paragraph on page 6 of the provisional application of Shiloh fails to teach or suggest how and by what means "virtual information of a virtual user" is communicated "to at least one of a plurality of entities *within a virtual world*" as recited in claim 16.

Therefore, it is submitted that claim 16 is patentable over the provisional application of Shiloh.

Accordingly, withdrawal of the rejection is respectfully requested.

#### **Summary**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: /Sheetal S. Patel/  
Sheetal S. Patel  
Registration No. 59,326

1201 New York Avenue, N.W., 7th Floor  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501